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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,877	05/23/2001	Takaaki Amano	100809-16253 (SCET 18.699	9471
7590 07/06/2007 KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK,, NY 10022-2585			EXAMINER JANVIER, JEAN D	
			ART UNIT 3622	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/863,877

Applicant(s)

AMANO ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **Response to Applicant's Arguments**

In view of the Appeal filed on 02/14/07, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

In general, the Applicant's arguments are moot in view of new grounds of rejection.

### **Detailed Action**

### **Specification**

### **Status of the claims**

Claims 2 and 3 are canceled and claims 1 and 4-9 are currently pending in the Instant Application.

### **General Comments**

Through the claimed invention or more particularly throughout the independent claims, the user or customer has never been exposed to the advertisement in the past and the storage device contains no points since the user has not viewed or selected any advertisements thus far.

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In other words, past interactions or older points accumulation record were not available since the claims never recite such elements. Thus, the display point degree will not decrease when the user views the advertisement since it will be the first time that the user has seen the advertisement.

Furthermore, decreasing a point degree for displaying the same advertisement on a subsequent encounter after the user has been exposed to the advertisement. However, it is rather unclear here whether or not the subsequent display of the advertisement is to the same user or to other users.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 4 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is said to be ambiguous or confusing for reciting “The advertisement supplying system as claimed in claim 1 wherein: a minimum value of the point degree to be displayed is equal to zero” since parent claim 1 recites that **“the point degree does not decrease to zero”**.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 8, 9 and 10 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The

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claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Here, although fig. 5 appears to show that the display point degree can be equal to zero (0), however, the specification, including the portions mentioned by the Applicant, does not immediately support that **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**. To this end, the claims will be given their broadest interpretation in accordance with the specification.

Claims 1, 5, 8, 9 and 10 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. **In fact**, the relationship between the “display point degree”, the “points themselves”, “point-appearing time” and “point-appeared time” is not clear and the portions mentioned by the Applicant do not clarify that either. In general, the specification simply repeats what it is shown in the drawings. Further, it is unclear how the “point degree” is being computed or determined with respect to the points. The relevance of the “display point degree”, as far as the subject matter or patentability is concerned, is not defined so as to enable one of ordinary skills in the art to practice the invention or to at least apply a point degree in combination with a point assignment to a banner ad (metes and bounds problem). Moreover, the Examiner notes that the “point degree” or “display point degree” is not a factor/multiplier or some kind of indexing. In short, the significance or contribution of the “point degree” to the claims is not clearly or

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immediately appreciated. To this end, the claims will be given their broadest interpretation or the “display point degree” is interpreted as “point display”.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-10 are rejected under 35 USC 102(b) as being anticipated by Golhaber, US Patent 5, 794, 210,

As per claims 1 and 4-10, Goldhaber discloses a system wherein, in one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to others, in accordance with their interest profile 124 (targeted advertisements). The advertiser 62 provides or forwards the created and targeted ads 68 to the Attention brokerage server 106, for permanent storage and later retrieval (storage apparatus), acting as a broker or intermediary between the consumers or viewers 64 and advertisers 62, which transmits or routes the one or more created ads 68 to appropriate consumers 64, upon logging into the system or server 106, contingent upon their psychographic profile 124 (identification data), stored on the Attention brokerage server 106, matching the advertiser's 62 interest profile or criteria (displaying a targeted ad on the viewer's terminal 104 upon identifying the user or viewer when the viewer logs into the server or storage apparatus 106 over the network 102). In short, Attention brokerage servers 106 store information and disseminate it to consumers' computers 104 over a network 102 (Internet) and the servers 106 provide the software agent 110 with targeted or tagged ads, directed to the

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consumers' or users' attention in accordance with their interest profile 124, to be viewed or reviewed by consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's 64 device or computer 104, working on behalf of the user, screens and filters the incoming ads 68, provided to the Attention brokerage server 106 by advertiser or advertisement owner 62, transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on the user's psychographic information 124 stored on the user's computer 104 local database 120. Subsequent to this screening or filtering process, matches achieving a certain threshold of interest (adjustable by the consumer who owns the profile) represented in the form of "agent reports" consisting of short summaries or thumbnails or pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail view indicative of an ad matching, the user's computer 104 or the software agent 110 retrieves the full text and/or graphics corresponding to the matched advertisement 68. In other words, the software agent 110 maintains the user's psychographic or interest profile 124 confidential and performs the screening, filtering and matching itself based on a correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62, and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106, which stores in a database the advertiser's ads, delivers the matching ads to the user's computer 104 or the software agent 110 may itself retrieve the matching ads from the Attention brokerage server 106 database to be displayed on the user's computer 104.

Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads, associated with a plurality of advertisers, and display them along with associated

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Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, showing a related dollar figure, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin (displaying a point degree in combination with an advertisement from an advertisement owner or advertiser).

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61; col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

Further, Goldhaber discloses a method of and system for brokering and selling the attention of a customer wherein, among other things, advertisers pay or compensate the customer for the opportunity to have their ads read by the customer or subscriber of the system. By clicking on a Cybercoin button (or banner, ad box or link) or selectable object, displayed on the customer's PC 104 and representative of an ad, the customer indicates his intention to read the said ad and once the system verifies, through a quiz process, that the customer has indeed read or interacted with the ad or advertisement, which guarantees that the advertiser's message has received full human attention or interaction, the customer is compensated in the form of credits or digital cash (points) for paying attention to the ad. **Here, the value of the credits or digital cash (displayed points degree) is equal to the amount shown on the Cybercoin. As time goes by, the customer accumulates a certain amount of credits or digital cash (points balance) for reading a plurality of targeted ads from a plurality of advertisers, wherein the credits balance or digital cash balance (points total) is stored in a database or customer's digital cash repository 126 and the customer's digital cash repository or the customer's account**



**storing the customer's credits is debited for the customer's use or ordering of information unit, medical report, service, goods, movies, etc (redemption of credits or digital cash).**

In addition, Goldhaber discloses a system wherein one or more ad titles or thumbnails are displayed on the customer's terminal along with one or more respective selectable objects or Cybercoins showing the associated monetary amount that the customer will earn if he activates a particular selectable object to read the corresponding advertisement (full version of the ad).

(Col. 16: 6-64; fig. 12; col. 7: 48-61; col. 11: 32-38) and (Col. 4: 47-63; Col. 19: 56-67; figs. 10-11).

Furthermore, Goldhaber discloses a system wherein advertisers pay users to view their advertising messages in accordance with the user's profile matching the advertisers' criteria or specifications (advertiser's rule to determine a point degree or monetary value of a displayed Cybercoin related to an ad). For example, if a user provides no profile data to an interesting advertiser, then the point degree or the monetary value shown on a displayed Cybercoin, related to an advertisement from an advertiser, is less significant. On the other hand, if the user makes his profile available to the interesting advertiser, who uses the profile information to tailor his ads to the user, then the displayed point degree or monetary value related to the displayed Cybercoin corresponding to the advertisement from the advertiser is more significant (col. 14: 5-10). In another embodiment, the point degree or the monetary value related to a displayed Cybercoin corresponding to an ad from an advertiser is determined based on the highest bid amount offered by an interesting advertiser from a plurality of advertisers for the opportunity to present at least one ad to a targeted user, wherein the bidding process may be silent (passive) or active (advertiser's criteria to determine a point degree...-col. 4: 32-64).

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Additionally, Goldhaber discloses a system wherein once a user has successfully activated a displayed Cybercoin and adequately read or interacted with the associated advertisement, then the user's digital cash repository 126 is updated or increased accordingly and **the displayed Cybercoin is deactivated (or its value is now equal or decreased to zero)** to prevent the user from repeatedly clicking on the Cybercoin in the future to read the same advertisement and being compensated for such actions (fig. 12; col. 17: 33-63). It is further recognized that the displayed Cybercoin 62 (selectable object or banner) may be replaced with a coupon icon 63, which performs similar functions (sort or type of point degree or Cybercoin 62 or coupon icon 63 monetary value or amount-col. 18: 13-33).

In short, Goldhaber teaches a system wherein a Cybercoin (display point degree) is displayed on the user's screen along with a targeted ad (in the form of a thumbnail or otherwise-fig. 11) and the user's account or digital cash repository 126 is increased by an amount equal to the value of the displayed Cybercoin or display point degree. Here, when the user clicks on the ad for the first time, the value of the Cybercoin or display point degree is greater than zero (the display point degree does not decrease to zero at this stage). However, in one specific embodiment, it is described that once the user has seen the ad, at least once, the user will not be compensated in the future for reading the same ad. In other words, the value of the Cybercoin or display point degree associated with the same displayed ad decreases to a zero value subsequent to the user reading the ad at least once (Here, at least, Goldhaber hints on the step of displaying the same ad to the user more than once and decreasing the value of the point (degree) or Cybercoin to zero for subsequent viewings of the same advertisement once the user has viewed

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the advertisement in a first period of time and received the displayed compensation or point or Cybercoin).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent %, 724, 521 to Dedrick discloses a system for storing a user's profile information, including user's interaction with displayed electronic content and/or advertisements, on the user's computer wherein no outside third party has access to the user's stored profile information.

US Patent 5, 974, 398 to Hanson discloses an interactive information and entertainment service customers see advertisers' bids for their attention which are displayed on their display screens and choose which advertisements to view. For each advertisement viewed, the advertisers' bid amount would pay for a portion of the user's service or usage charge. A display on the user's terminal screen includes the advertisers most willing to pay for the user's attention and the dollar amount bid. If the user chooses to see a particular advertiser's message, then the user is reimbursed, or a credit is applied to the user's service account for the amount of the bid promised by the advertiser whose message was viewed. Customer interest profiles and service usage data collected by the service provider are used to identify particular user characteristics to advertisers. Advertisers define user characteristics of particular desirability and place a dollar value on having messages viewed by individual users based on the desirability of the user (See abstract; figs. 4-5).

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

06/24/07

JDJ

JEAN D. JANVIER  
PRIMARY EXAMINER



Jean D. Janvier

Patent Examiner

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A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



Eric W. Stamber (3622 SPE)